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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,183	03/11/2004	Josephus Hubertus Cornelius Maria Dekkers	143565-1	5302

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,183

Applicant(s)

CORNELIUS MARIA DEKKERS ET AL.

Examiner

William K. Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 042406.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. In view of amendment filed March 30, 2006 and July 6, 2006, claim 3 has been cancelled. Claims 1, 2, 4-22 are pending. Claims 20-22 are drawn to non-elected subject matter. Claims 1, 2, 4-19 are examined with merit.
2. The examiner has considered and initialized the IDS filed April 24, 2006.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/797975. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the process invention of claims 1-20 of copending Application No. 10/797975 fully encompasses the invention of claims 1, 2, 4-19 of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed March 30, 2006 and July 6, 2006 have been fully considered but they are not persuasive. The instant provisional ODP is maintained until a terminal disclaimer is filed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Podszun et al. (US 6,365,066) for the reasons adequately set forth from paragraph 6 of the office action of April 25, 2006.

Applicant's arguments filed March 30, 2006 and July 6, 2006 have been fully considered but they are not persuasive.

Regarding applicants' argument that the examiner statement "in view of the substantially identical composition of Podszun et al. and the composition as claimed" (which was original set forth in the office action filed October 4, 2005) fail to provide any rationale for the 102/3 rejection set forth, the examiner disagrees.

Applicants must recognize that if the examiner does not find the composition of the claimed composition and the composition of Podszun et al. to be substantially

identical and relevant to the "biocidal release" properties being claimed, the examiner has no basis to issue the 102/3 rejection set forth. In fact, the composition being claimed is a critical in considering the "biocidal release" properties being claimed. Applicants must recognize that the claimed "article" of claim 1 would not possess any "biocidal metal release" properties in the absence of "an inorganic biocidal agent" recited in claim 1.

When applicants argue that Podszun et al. are silent on a "textured exterior surface", applicants must recognize that a "textured exterior surface" means any non-smooth surfaces, which applicants have already acknowledged in the response filed March 30, 2006 (page 9). Then applicants continue to argue that Podszun et al. (col. 9, example 6) teach away from the claimed invention because Podszun et al. designate example 6 as a comparative example. Regarding example 6 of Podszun et al, the disclosure is not considered "a teach away". Applicants must recognize that the teachings of a prior art is not limited to its preferable embodiments or working examples. The teachings of example 6 in Podszun et al. clearly indicate the existence of an article comprising the composition (a thermoplastic resin and an inorganic biocidal agent" as claimed comprising a rough surface property that can be considered "textured". Applicants must also recognize that Podszun et al. (col. 9, line 65-66) clearly indicate that the active substances are visible to the naked eyes.

Regarding applicants' argument that the claimed "textured" surface is achieved by mechanical and chemical means, applicants must recognize that these argued features are not the claims.

Regarding applicants' argument that the examples disclosed in Podszun et al. (col. 9, line 25) must form smooth surfaces because the employed solvent (toluene), this is not true. Applicants must recognize that when a solvent evaporates from a polymer solution, the local difference in evaporation rates would cause uneven thickness throughout the surfaces, even with a doctor-blade. The "biocidal agents" in the solution can also phase out too. Any way, Podszun et al. are silent that the films obtained in the working examples are smooth.

In view of the reasons set forth above, the examiner has a reasonable basis that the argued "texture surface" is inherently possessed in Podszun et al. Therefore, regarding applicants argument that the sample with smooth surface exhibit less effective biocidal metal release properties or all the claimed improved "biocidal metal release" related properties, applicants must recognize that the argued improvement is an "expected" properties since a smooth surface has reduced surface area which reduces the amount of surface area in contact for biocidal activities. Applicants must also recognize that Podszun et al. (col. 9, line 65-66) clearly indicate that the active substances are visible to the naked eyes.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

July 25, 2006

WILLIAM K. CHEUNG
PRIMARY EXAMINER